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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,143

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David E. Penna

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EXAMINER

CORRIELUS, JEAN B

ART UNIT

PAPER NUMBER

2611

MAIL DATE

DELIVERY MODE

09/30/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/574,143	Applicant(s) PENNA ET AL.	
	Examiner Jean B. Corrielus	Art Unit 2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 August 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in United Kingdom on 10/4/03. However, the certified copy of the application filed on 3/29/06 is not legible it required to refile a legible certified copy of the foreign application as required by 35 U.S.C. 119(b).

Drawings

2. The drawings were received on 8/12/10. These drawings are acceptable.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) THE NAMES OF THE PARTIES TO A JOINT RESEARCH AGREEMENT.
- (e) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC.
- (f) BACKGROUND OF THE INVENTION.

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- (1) Field of the Invention.
- (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (g) BRIEF SUMMARY OF THE INVENTION.
- (h) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (i) DETAILED DESCRIPTION OF THE INVENTION.
- (j) CLAIM OR CLAIMS (commencing on a separate sheet).
- (k) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (l) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

Allowable Subject Matter

4. The indicated allowability of claims 1-44 is withdrawn in view of the following new grounds of rejections.

Claim Objections

5. Claims 4-14, 19 and 25-35 are objected to because of the following informalities:

Claim 4, line 3, before "memory", "the/said" should be inserted, so as to make use of antecedent.

Claim 5 recites "said tiled format" in line 2. However there is no antecedent basis for such limitation recited in claim. It appears that the dependency should have been "4" instead of "3". Please correct.

Claim 6, line 3, before "memory", "the/said" should be inserted, so as to make use of antecedent.

Claim 8, "{original}" should be replaced by "(original)".

Claim 11, line 3, before "memory", "said/the" should be inserted; lines 4-8 recites "G.-J." however there are no steps "A.-F."

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Claim 19, line 2, replace "it" by its term.

Claim 25, line 4, before "memory", "the/said" should be inserted, so as to make use of antecedent.

Claim 26 recites "said tiled format" in line 2. However there is no antecedent basis for such limitation recited in claim. It appears that the dependency should have been "25" instead of "24". Please correct.

Claim 27, line 4, before "memory", "the/said" should be inserted, so as to make use of antecedent; line 9, ",-" should be replaced by ";;".

Claim 31, line 2, "said/the" should be inserted "measuring means", second occurrence.

Claim 32 needs to be terminated by a period; line 4, before "memory", "said/the" should be inserted; lines 5-10 recites "G.-J." however there are no steps "A.-F."

Claim 35, line 3, before "memory", "the/said" should be inserted, so as to make use of antecedent.

Any claim whose base claim is objected is likewise objected.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 6-14, 18-21, 27-35, and 39-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6, line 4, "the received data" lacks of antecedent basis; line 9 and line 10, "the sequence header" and "the image stream", lack of proper antecedent basis, respectively.

Claim 11, "the end user" and "the content" lacks of proper antecedent basis.

As per claim 17, it is unclear how a memory can be selected by "selecting different versions of code to be executed", as now recited in the claim.

As per claim 18, it is unclear how the goal set forth in the preamble of the claim is reached in the body of the same. In addition, the step "using cache handling functions under program control", recited in the claim is unclear.

As per claim 27, see claim 6.

As per claim 32, see claim 11.

As per claim 39, see claim 17.

As per claim 40, "using cache handling functions selectively under program control", recited in the claim is unclear.

Any claim whose base claim is rejected is likewise rejected.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 22- 44 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The specification page 2, lines 13-29 and page 13, lines 1-8, states that the invention can be implemented by software. Under the

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broadest possible interpretation, the claims, 22-43, are fairly interpreted as software.

Claims directed to software are non-statutory.

As per claim 44, per the preamble, line 1, the claim is directed to a computer program per se. However, claim directed to a computer program is nothing but software and are non-statutory.

10. Claims 1-21 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example the method including the step of selecting”, recited in claim 1, is of sufficient breadth that it would be reasonably interpreted as a step completely performed mentally, verbally or without a machine. The claim fails to recite any corresponding hardware in combination with the method step(s) so as to effectively tie the process claim with a statutory class of invention, i.e. apparatus.

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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Although a “memory” and “processing system” are recited in the claim, they are not required in the performing of the step itself and therefore are neither an explicitly recited structural tie nor inherently involved in the step.

Absent a special definition in the specification limiting the selecting step to a machine implementation, **this claim is not properly tied.**

Similar analysis applies to claims 2-21, respectively.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 1, 6, 22, 27 and 43-44 are rejected under 35 U.S.C. 102(b) as being anticipated by Naimpally et al US patent No. 5,874,995.

As per claim 1, Naimpally teaches a method and apparatus fig. 2 comprising circuitry that configures the memory to allocate data areas suitable for decoding signals either in progressive or interlaced format (dynamically selecting the arrangement of image data for successive pictures of said sequence in said memory) according to the produced (measured) indication signal (characteristics of said image data) . (Note col. 2, lines 55-65).

As per claim 6, the picture type is detected (measured) note col. 2, lines 55-65.

As per claim 22, see claim 1.

As per claim 27, see claim 6.

As per claim 43, see claim 1.

As per claim 44, see claim 1.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 2-3, 9, 23-24, 30 and 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable Naimpally et al US patent No. 5,874,995.

As per claim 2, Naimpally et al teaches every feature of the claimed invention. But does not explicitly teach the further limitation of constructing the memory from paged memory. However, examiner noted that constructing a memory from paged memory is well established in the art. It would have been obvious to one skill in the art to incorporate such a teaching in Naimpally et al so as to enhanced processing of the image stored in the memory.

As per claim 3, one skill in the art would have been motivated to provide a cache memory in addition to the main memory, the system efficiency would have been improved since the cache memory would have allowed easy access to previously stored files.

As per claim 9, it would have been obvious to one skill in the art to use averaged technique in measuring the image characteristics so as to enhance the accuracy of the system.

As per claim 23, see claim 2.

As per claim 24, see claim 3.

As per claim 30, see claim 9.

As per claim 37, one skill in the art would have been motivated to implement the system in the manner recited in claim 37 in order to minimize production cost since less hardware would have been used.

As per claim 38, one skill in the art would have been motivated to implement the selecting means as recited in the claim for increased performance.

As per claim 39, see claim 38.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean B. Corrielus whose telephone number is 571-272-3020. The examiner can normally be reached on Monday-Thursday from 9:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chieh Fan can be reached on 571-272-3042. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jean B Corrielus/
Primary Examiner, Art Unit 2611